

REMARKS

In the Final Office Action¹, the Examiner rejected claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,729,694 to Holzrichter et al. ("Holzrichter") in view of U.S. Patent No. 4,654,883 to Iwata ("Iwata"). Claims 1-16 remain pending.

Applicants respectfully traverse the Examiner's rejection of claims 1-16 under 35 U.S.C. § 103(a) as being unpatentable over Holzrichter in view of Iwata. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P.* § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P.* § 2143.01 (III), *internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P.* § 2141.02(1), *internal citations omitted* (emphasis

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement of characterization in the Final Office Action.

in original).

Independent claim 1 recites a "microphone being installed on a surface of the skin on the sternocleidomastoid muscle immediately below the mastoid of the skull, that is, in the lower part of the skin behind the auricle." The applied prior art does not teach at least these elements of claim 1, and does not render claim 1 obvious.

The Examiner correctly states that "Holzrichter fail[s] to teach" the claimed "microphone being installed on a surface of the skin on the sternocleidomastoid muscle immediately below the mastoid of the skull, that is, in the lower part of the skin behind the auricle." See Final Office Action, page 3. The Examiner relies on Iwata to allegedly disclose these elements. This is not correct.

The Examiner states that Iwata "teaches that the position of microphone 17 is slidably adjustable along the back of the ear (retaining mechanism 13/16, col. 3, lines 6-29)." Final Office Action, page 3. The Examiner further alleges that since the position of the microphone 17 can be adjusted within a certain range, attaching the microphone right below the mastoid can be realized. See Final Office Action, page 3. However, this is not correct. Iwata does not teach that a microphone can be moved, as the Examiner suggest.

Iwata discloses that "The other end of a sliding rod 16, on one end of which is mounted a bone transmission type microphone 17, is slidably retained on the other retainer member 13. A locking piece 18 to be hooked on the upper portion of the ear is projected on the bone transmission type microphone 17." Iwata, Col. 3, lines 16-21. Thus, Iwata implies that when using the bone transmission type microphone 17, the microphone is fixed at the side head with the locking piece 18 hung on the ear.

Therefore, according to Iwata, as shown in Figures 1 and 2, the bone transmission type microphone 17 and the locking piece 18 are integrated to be fixed to the sliding rod 16; hence, with the locking piece 18 hung on the ear, the bone transmission type microphone 17 cannot be moved downward to be mounted just below the mastoid. For at least these reasons, the disclosure of Iwata does not teach the claimed "microphone being installed on a surface of the skin on the sternocleidomastoid muscle immediately below the mastoid of the skull, that is, in the lower part of the skin behind the auricle," as recited in claim 1.

Further, Applicants advise that Iwata teaches a bone transmission type microphone, and also teaches that the "bone transmission type microphone 17 comes into contact with a side head portion at the rear of the other rear when the head band 11 is put on the user's head and the earphone speaker 14 comes into contact with one ear as shown in FIG. 2." Iwata, Col. 3, lines 30-34. Moreover, Iwata states that "in the bone transmission type microphone 17, the voice sound generated within the mouth of a person is formed into oscillation, which is transmitted to the bone tissue of the side head portion." Iwata, Col. 4, lines 15-18. Thus, as can be understood from the description in Iwata, the microphone disclosed by Iwata is one that is mounted at the back of the ear of the side head portion to collect the vibration sound to be transmitted to the bone tissue. Whereas, the present invention is directed to a microphone that is installed on the skin surface on the sternocleidomastoid muscle immediately below the mastoid of the skull to collect the vibration sound transmitted through internal soft tissues. As a result, the present invention differs from Iwata in the installation position and the sound to be collected.

As discussed, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(1), internal citations omitted (emphasis in original).

Again, as set forth in the MPEP §2143:

The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted the analysis supporting a rejection under 35 U.S.C. §103 must be made explicit.

Here, Applicants’ claimed invention as a whole would not be obvious in view of the cited prior art because the Examiner merely selects differences between Iwata and the claimed invention, but, in view of the mischaracterizations of Iwata, does not provide a reason why one of ordinary skill in the art, at the time the invention was made, would modify Iwata in a manner contrary to its purpose. Moreover, the Examiner has not identified any predictability or reasonable expectation of success of such a modification.

For at least the above reasons, the Examiner has failed to clearly articulate a reason why the prior art would render claim 1 obvious to one of skill in the art, and a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a). Claim 1 is thus allowable over the art of record. Claims 2-16 are also allowable at least due to their dependence from claim 5.

The Examiner also cited U.S. Patent No. 4,972,468 to Murase et al. (“Murase”) as being considered pertinent to Applicants’ disclosure. Murase discloses the following:

a) "The microphone is held in engagement with rear portion of the individual's head to be shielded from the external wind noise." Murase, Col. 1, lines 66-68;

b) "The microphone 41 is carried at the outer end of the arm 48 and will be pressed against the rider's skull through the skin so as to provide good pickup of sounds emanated when the weaver speaks." Murase, Col. 3, lines 44-47; and

c) "In the embodiments of the invention as thus far described, the microphone has been positioned below and slightly to the rear of the wearer's auditory canal." Murase, Col. 5, lines 5-7.

Applicants advise that the microphone of Murase is positioned on the skull and below and slightly to the rear of the wearer's auditory canal at the back of the head. This position is different from the position of the present invention. Since the microphone in accordance with the present invention is installed on the skin surface on the sternocleidomastoid muscle immediately below the mastoid of the skull, in the lower part of the skin behind the auricle, the microphone excels in picking up the vibration sound transmitted through internal soft tissues, which is the greatest feature. The position of the microphone is specified as a pinpoint that excludes circumferential portions thereof, and produces an outstanding effect compared with the circumferential portions.

Accordingly, taking into account the extremely limited installation position of the microphone and the characteristics of the sound through internal soft tissues transmitted by the microphone, the present invention concerning the microphone would not have been easily made based on the prior art. Thus, for these additional reasons, the claims are allowable over the prior art.

CONCLUSION


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The arguments presented herein do not raise new issues beyond responding to the Final Office Action , and do not necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Request for Reconsideration after Final should allow for immediate and favorable action.

Respectfully submitted,

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